



1 2 SEP 2007

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CANADA

In re Application of	:	DECISION
SEMLYEN et al.	:	
Application No.: 10/550,759	:	
PCT No.: PCT/CA2004/000458	:	
Int. Filing Date: 26 March 2004	:	
Priority Date: 26 March 2003	:	
Attorney Docket No.: 13180-79	:	
For: DIAGNOSIS OF DISEASE BY	:	
DETERMINATION OF ELECTRICAL	:	
NETWORK PROPERTIES OF A BODY PART	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 03 July 2007 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

### **BACKGROUND**

On 26 March 2004, applicants filed international application PCT/CA2004/000458, which designated the U.S. and claimed a priority date of 26 March 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 07 October 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 26 September 2005.

On 26 September 2005, applicants filed a transmittal letter for entry into the national stage in the United States. However, no fees accompanied the transmittal letter.

On 15 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to provide the U.S. Basic National Fee by thirty months from the earliest priority date.

On 07 August 2006, applicants filed a petition to revive under 37 CFR 1.137(b) and an assertion of small entity status

On 20 September 2006, a decision was mailed granting applicants' petition to revive under 37 CFR 1.137(b).

On 03 January 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage were required.

On 03 July 2007, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a four month extension of time, the surcharge under 37 CFR 1.492(h), a declaration of inventors, a statement of facts by Stephen M. Beney, and a copy of an e-mail exchange with joint inventor Adam Semlyen.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 has been charged to Deposit Account 02-2095. Thus, item (1) has been met.

Items (3) and (4) have been met as well.

Item (2) has not been satisfied. MPEP § 409.03(d) states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

The declaration of facts by Mr. Beney filed 03 July 2007 makes it clear that Mr. Semlyen understands exactly what he is being asked to sign. However, a statement of facts by a person having firsthand knowledge of the facts recited therein must be provided. A statement of facts by Milan Graovac regarding the e-mail from Mr. Semlyen to him dated 24 August 2004 must be provided. Additionally, a statement of facts from the person from Z-Tech who agreed with Mr. Semlyen "that it would respect his wishes and not bother him further having regard to the patent application" after having been able to procure an execution of an assignment from Mr. Semlyen should also be provided.

### **CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without

prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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